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09/128,573	08/04/98	MAKI	R 10739.17. <i>lg</i>

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EXAMINER

HERRON II, D

ART UNIT

PAPER NUMBER

3619

5

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/128,573**

Applicant(s)  
**Maki, et al.**

Examiner  
**David E Herron II**

Group Art Unit  
**3619**



☒ Responsive to communication(s) filed on Aug 4, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-18 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Drawings*

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,2,4, 17, and 18 include non-statutory subject matter, as follows:

The applicant has used language including a human body or parts thereof. Examples include, but are not limited to the following:

- a. “.... seat sufficiently narrow to be straddled by *a rider*;” found in claim 1, line 3; claim 17, line 3; and claim 18, line3.
- b. “... at least a portion of *a foot* ...” in claim 2, line 3;
- c. “ ... to prevent a rider’s shoe...” in claim 4;
- d. “... sufficiently large to permit *a toe of a rider’s foot*...” in line 3 of claim 5.

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Because the human body, and any part thereof, is nonstatutory subject matter under 35 USC 101, the applicant shall cautiously and carefully draft claims to ascertain that no parts of the human body are positively set forth as elements of any claim. See, 1077 OG 24. (04/21/87).

The intent to refrain from claiming nonstatutory subject matter should be more clearly set forth in the claim language. Editing of the claim language is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the initial 4 lines of each of these claims, the applicant sets forth the limitation, “... a seat ***sufficiently narrow*** to be straddled by a rider...” yet fails to positively set forth a more concrete dimension. Correction is required.

5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Lines 1-2 include the phrase, “... the platform ***optionally includes*** ....” Additionally,

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the phrase, "... no such hole *sufficiently large* to permit ...." These phrases render claim 5 indefinite. Correction is required.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Lines 1-2 include the phrase, "... the platform *optionally includes* ...." These phrases render claim 6 indefinite. Correction is required.

7. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language includes dangling modifiers. For example, in line 13, it is unclear whether the phrase "... *for shifting the transmission* ..." modifies the *footrests* or the *shift lever*. Again in lines 15-16, it is unclear whether applicant intends the phrase, "... *having generally horizontal heel and toe portions*..." to modify the *shift lever* or the *footrest*. Correction is required.

8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language includes a dangling modifier. In line 28, it is unclear whether the phrase "... *for shifting the transmission* ..." modifies the *footrests* or the *shift lever*. Correction is required.

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***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hisada.

Regarding Claim 1, Hisada discloses an all terrain vehicle (Fig 2), comprising a chassis (See Fig 3; Ref 10) carrying a straddle-type seat (20) which is sufficiently narrow to be straddled by a rider; a pair of front wheels (12) mounted to the chassis (10), and handlebars (15) connected to the front wheels, a pair of rear wheels (13) mounted to the chassis (10), a laterally extending footrest (22c) on one side of the chassis (10), an engine (11) carried by the chassis and connected to a manual transmission (impliedly disclosed at Col 3, lines 32-36) which in turn is connected to a drive chain (Id) supplying motive power to at least some of the wheels, the transmission including a foot-operable shift lever (27) located on one side of the chassis adjacent the footrest (22c) for shifting the transmission among a plurality of forward gears, the footrest having generally horizontal heel (68) and toe (47,57) portions, wherein the shift lever (27) is positioned above the toe portion of the footrest, and the toe portion being positioned lower than the heel

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portion, permitting a rider to depress the shift lever to a position lower than the heel portion of the footrest. (See Fig 9).

Regarding claim 18, Hisada discloses an all terrain vehicle (Fig 2), comprising a chassis (See Fig 3; Ref 10) carrying a straddle-type seat (20) which is sufficiently narrow to be straddled by a rider; a pair of front wheels (12) mounted to the chassis (10), and handlebars (15) connected to the front wheels, a pair of rear wheels (13) mounted to the chassis (10), laterally extending footrest (22c) on one sides of the chassis (10), an engine (11) carried by the chassis and connected to a manual transmission (impliedly disclosed at Col 3, lines 32-36) which in turn is connected to a drive chain (Id) supplying motive power to at least some of the wheels, the transmission including a foot-operable shift lever (27) located on one side of the chassis adjacent the footrest (22c) for shifting the transmission among a plurality of forward gears, the footrest located adjacent to the foot-operable shift lever (27) having generally horizontal heel (68) and toe (47,57) portions, the toe portion being positioned lower than the heel portion.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 3-6, 10, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisada.

Hisada discloses each of the elements of parent claim 1, as set forth above. Hisada impliedly discloses that the footrest should have ample space to comfortably receive the rider's foot and provide protection from the elements. Consequently, Hisada is construed to impliedly disclose and/or suggest the following:

i. that the heel and toe portions are defined by a continuous platform having a width of at least about four inches and a length of at least about one foot, and that the shift lever is at least about three inches forwardly of the heel portion of the footrest; and,

ii. that the footrest has a width of at least about four inches and a length of at least about one foot; and,

iii. that the footrest has a width of at least about five inches and a length of at least about fifteen inches.

As for the feature of the platform footrest holes which permit water to drain therethrough, such holes being sized and positioned to prevent a rider's shoe from extending therethrough, this is an obvious feature as shown in Hisada's fig 4 and elements 59 and 72.

However, absent a teaching of criticality regarding the specific dimensions pointed out in elements i, ii, and iii, the limitations set forth therein are construed as obvious design choices.



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Additionally, absent a teaching of criticality of the dimensions of the footrest and the spacing of the shifting lever, the examiner considers the claimed dimensions (i.e., claim 3, 10, 15, 16) to be design choices based upon the average size of a person's foot or shoe.

13. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisada in view of Graves. Hisada discloses all of the elements of parent claim 1, as set forth above. Hisada also discloses that the heel and toe portions are defined by a continuous platform having holes (57,69). Hisada does not specifically disclose the following, however:

a. that the shift lever is positioned above the toe portion and forwardly of the heel portion a sufficient distance to permit the rider to insert at least a portion of a foot beneath the shift lever, allowing the rider to move the shift lever upward to shift the manual transmission.

Graves discloses an all terrain vehicle (10), with a footrest having generally horizontal heel (60) and toe (68,32) portions, wherein the shift lever (36) is positioned above the toe portion (68,32), and forwardly of the heel portion a sufficient distance to permit the rider to insert at least a portion of a foot beneath the shift lever, allowing the rider to move the shift lever upward to shift the manual transmission.

It would have been obvious to modify the ATV of Hisada in accord with the teaching of Graves to include a footrest having generally horizontal heel (60) and toe (68,32) portions, wherein the shift lever (36) is positioned above the toe portion (68,32), and forwardly of the heel

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portion a sufficient distance to permit the rider to insert at least a portion of a foot beneath the shift lever in order allow the rider to move the shift lever upward to shift the manual transmission.

Regarding Claim 9, Hisada discloses each of the limitations of parent claim 1, but does not explicitly disclose that the range of motion of the shift lever. In contrast, Graves discloses an ATV wherein the gear shifting lever (36) is movable vertically through a range of motion having upper and lower ends, the shift lever (36) being spaced above the toe portion (68,32) of the footrest when the shift lever (36) is at its lower end of movement (See, Fig 1; see also, col 2, lines 60-65; col 4, lines 1-5). It would be obvious to one having ordinary skill in the art to modify the ATV of Hisada in accord with the teaching of Graves to include a footrest wherein the gear shifting lever (36) is movable vertically through a range of motion having upper and lower ends, the shift lever (36) being spaced above the toe portion (68,32) of the footrest when the shift lever (36) is at its lower end of movement in order to allow the rider to shift gears.

14. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisada in view of Graves, as applied to claim 6 above, and further in view of Walters et al.

Graves and Hisada combine to disclose each of the elements of claim 6, as set forth above.

Neither Graves nor Hisada discloses a cleat disposed at a forward edge of the heel portion, the cleat being formed integrally with the platform, defining the forward edge of the heel portion and

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the rearward edge of the toe portion, and further having an upper surface positioned higher than the heel portion of the footrest. In contrast, Walters et al. depicts a footrest for a recreational vehicle (see Figure 1) having a cleat (Id) disposed at a forward edge of the heel portion, the cleat being formed integrally with the platform, defining the forward edge of the heel portion and the rearward edge of the toe portion and further having an upper surface positioned higher than the heel portion of the footrest. The cleat portion allows the rider to keep a secure grip on the footrest. It would have been obvious to modify the combination of Graves and Hisada in accord with the teaching of Walters to include an integrally-formed, raised cleat portion, which defines the boundary between the heel portion and toe portion of the platform, in order to prevent injury that may result from the rider's feet from slipping off the footrest.

15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graves in view of Hisada, and further in view of Millican. Graves discloses an all terrain vehicle (10), comprising a chassis (22) carrying a straddle-type seat (see fig 1) which is sufficiently narrow to be straddled by a rider; a pair of front wheels (24; see also col 2, lines 50-53) mounted to the chassis (22), and handlebars connected to the front wheels (see, Fig 1) for steering the front wheels, a pair of rear wheels (26, 28) mounted to the chassis (22), a laterally extending footrests (14) on opposite sides of the chassis (22), an engine (54) carried by the chassis and connected to a manual transmission (impliedly disclosed at Col 2, lines 60-65) which in turn is connected to a drive chain supplying motive power to at least some of the wheels, the transmission including a

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foot-operable shift lever (36) located on one side of the chassis adjacent one of the footrests (14) for shifting the transmission among a plurality of forward gears, the footrest located adjacent to the foot operable shift lever having having generally horizontal heel (60) and toe (68,32) portions.

Graves does not disclose, however, that the toe portion is positioned lower than the heel portion, and that the shift lever is positioned at generally the same height as the heel portion.

Hisada discloses an all-terrain vehicle having a footboard defined by a continuous platform (22a) having a heel portion and a toe portion, wherein the toe portion (63) is positioned lower than the heel portion (68), permitting the rider to depress a lever (27d) to a positioned lower than the heel portion of the footrest (see, fig 9), which allows the rider to fully depress a lever downward.

Millican discloses a motorcycle foot guard having a heel portion (33) at generally the same height as the shift lever (19) in order to make the shift lever readily accessible to the rider. It would have been obvious to modify the all-terrain vehicle of Graves in accord with the teaching of Millican and Hisada to include a footrest having a raised heel portion adjacent to a manual-transmission shifting lever wherein the raised heel portion of the footrest is generally the same height as the shift lever in order to make shifting gears easier for the rider, and provide a protective resting place for the rider's feet.

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16. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisada in view of Walters.

Hisada discloses each of the elements of parent claim 1, as set forth above. Additionally, Hisada discloses that the heel and toe portions of the footrest are defined by a generally rectangular platform (See Fig 2), the footrest including front (23) and rear (25) walls extending upwardly from the edges of the platform, wherein the front wall of the footrest forms a part of the fender, and the rear wall of the footrest forms a part of the rear fender. (See, Figs 1&2). Hisada does not disclose, however, that the footrest should include a side wall.

Walters, et. al. discloses a footrest for an all-terrain vehicle having front walls *and* side walls (see, Fig 1). Side walls help keep the rider's feet on the platform. It would have been obvious to one having ordinary skill in the art to modify the all-terrain vehicle of Hisada in accord with the teaching of Walters to include a sidewall to reduce the risk of injury resulting from the rider's foot becoming dislodged from the footrest.

17. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hisada in view of Millican .

Hisada discloses an all terrain vehicle (Fig 2), comprising a chassis (See Fig 3; Ref 10) carrying a straddle-type seat (20) which is sufficiently narrow to be straddled by a rider; a pair of front wheels (12) mounted to the chassis (10), and handlebars (15) connected to the front wheels,

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a pair of rear wheels (13) mounted to the chassis (10), a laterally extending footrests (22c) on opposite sides of the chassis (10), an engine (11) carried by the chassis and connected to a manual transmission (impliedly disclosed at Col 3, lines 32-36) which in turn is connected to a drive chain (Id) supplying motive power to at least some of the wheels, the transmission including a foot-operable shift lever (27) located on one side of the chassis adjacent the footrest (22c) for shifting the transmission among a plurality of forward gears, the footrest located adjacent to the foot-operable shift lever (27) having generally horizontal heel (68) and toe (47,57) portions, the toe portion being positioned lower than the heel portion.

Hisada does not disclose, however, that the shift lever is positioned at generally the same height as the heel portion. Millican, however, discloses a motorcycle footrest adjacent to a shift lever (19) wherein the heel portion (33,49) is generally the same height as the shift lever (compare, Figs 1,2). It would have been obvious to one having ordinary skill in the art to modify the ATV of Hisada in accord with the teaching of Millican to include a footrest having a raised heel portion, wherein the footrest is adjacent to a gear shift lever and wherein the gear shift lever is generally the same height as the heel portion in order to provide the rider with easy access to the gear shift lever.

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*Conclusion*

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carone (5,661,999) discloses a motorcycle shift pedal assembly; Stillwagon (4,458,910) discloses a foot retainer for a motorcycle; and James, et al. (5,779,254) discloses a motorcycle footrest.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Herron II whose telephone number is (703) 306-4612, between 8:30 am and 5:00 pm (eastern time), Monday through Friday. In the event efforts to reach the examiner are unsuccessful, the applicant may contact examiner's supervisor, Lanna Mai, at (703) 308-2486.

*dh*  
DEHII

December 2, 1999

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